

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-5 and 7-22 remain in the application. Claims 5 and 7-11 are subject to examination and claims 1-4 and 12-22 have been withdrawn from examination. Claim 5 has been amended. Claims 6, and 23-24 have been previously canceled.

The change to claim 5 now recites that a plurality of register cut-outs are disposed in one and the same plate edge.

In item 5 on page 3 of the above-identified Office Action, claims 5 and 7-11 have been rejected as being unpatentable over Montgomery et al. (U.S. 5,947,028) (hereinafter "Montgomery") in view of Leanna et al. (U.S. 4,116,594) (hereinafter "Leanna") under 35 U.S.C. § 103(a).

It is noted that while the final rejection of the claims is based on Montgomery in view of Leanna, the Examiner has referred to Welch Jr. et al. (U.S. Patent 3,670,646) in at least two instances in her statements regarding the rejection. Since Welch Jr. is not mentioned in the rejection in the first sentence of item 5 on page 3, applicants assume that the reference to Welch Jr. is a typographical error and that the

Examiner intended to refer to Leanna instead of Welch, Jr..
Accordingly, applicants will treat the rejection as based on
Montgomery in view of Leanna.

The rejection has been noted and independent claim 5 has been
amended in an effort to even more clearly define the invention
of the instant application. Support for the changes is found
on page 20, lines 15-18 of the instant specification and as
shown by the features 33, 34 in Fig. 4 of the instant
application.

Before discussing the prior art in detail, it is believed that
a brief review of the invention as claimed, would be helpful.
Claim 5 calls for, *inter alia*, an imaging assembly, having a
printing plate, and an imaging machine for setting an image on
the printing plate, the printing plate formed of a
magnetically attractable material, the imaging machine
including **a magnetic cylinder magnetically holding the
printing plate firmly during the setting of an image thereon,
the magnetic cylinder having at least one magnet for
attracting the printing plate magnetically and being selected
from the group consisting of permanent magnets and
electromagnets, the magnetic cylinder having a register system
aligning the printing plate, and the printing plate having an**

edge, the substantially U-shaped register cut-outs being disposed in the edge. (emphasis added)

Montgomery discloses printing, printing plates, and drums therefor as disclosed in col. 1, lines 5 et seq. In particular, Montgomery discloses apparatus for holding metal printing plates on a rotating drum by the use of a vacuum. Holding the plates in place on the drum is facilitated by bending at least one edge of the plate to approximately match the drum curvature. Montgomery does not disclose or suggest **substantially U-shaped cut-outs** for aligning the printing plate accurately in position relative to the magnetic cylinder, before it is firmly clamped in place, according to the present claimed invention. Montgomery is silent on and does not disclose the use of magnets. The Examiner acknowledges that **Montgomery is silent** with respect to primary features of claim 1, namely, "the particular details of the magnetic drum and whether the magnetic material in the cylinder includes one of a permanent magnet and electromagnet" and "whether the drum includes a register system for aligning the printing plate with U-shaped register cut-outs."

Contrary to Montgomery, Leanna discloses embossing, embossing plates, and embossing rollers therefor. Leanna discloses an embossing apparatus for applying a continuous pattern to webs

of material such as paper and a method for producing an embossing surface. Further, in sharp contrast to the claimed invention, Fig. 15 of Leanna shows that the two register cut-outs 56" are located in two different plate edges or locations (and not in one and the same plate edge as recited in claim 5). In other words, the two plate edges or locations in Leanna are each provided with a single register cut-out 56 (and not with a plurality of register cut-outs as recited in claim 5).

Moreover, in item 5 of the above-identified final Office Action, the Examiner uses the terms "printing/embossing plate" and "magnetic printing/embossing drum", which is based on an erroneous assumption that printing and embossing are, by their nature, identical processes and therefore interchangeable.

Applicants submit that this assumption is incorrect, notwithstanding the statements in the Examiner's Answer. The combination of Montgomery and Leanna is based purely on hindsight reconstruction of the prior art in view of applicants' disclosure. One skilled in the art would not consider combining the references, because the printing of Montgomery and embossing of Leanna are completely different processes by their very nature and completely different equipment is required for the respective processes. Furthermore, Leanna actually teaches away from combining

Leanna with Montgomery. Leanna acknowledges that "printing and embossing differ both as regards equipment employed and the nature of the process" (see col. 2, lines 5-8), which further supports applicants arguments.

The Examiner's acknowledgements that Montgomery is **silent** with respect to claimed features of the present invention further supports applicants' argument that there is no reason to arbitrarily take from Leanna the features of a "magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets" and "the magnetic cylinder having a register system aligning the printing plate, and the printing plate having substantially U-shaped register cut-outs cooperating with the register system register system" and arbitrarily add them to Montgomery as proposed by the Examiner, but for applicants' disclosure. Therefore, it is submitted that the proposed combination of references is improper. Further, even if the references were combinable, the resulting structure still would not meet the claim limitations, in particular because Leanna does not disclose "...substantially U-shaped register cut-outs being disposed

in" one and the same edge of the printing plate as recited in independent claim 5.

Clearly, the references do not show "a magnetic cylinder magnetically holding the printing plate firmly during the setting of an image thereon, the magnetic cylinder having at least one magnet for attracting the printing plate magnetically and being selected from the group consisting of permanent magnets and electromagnets, the magnetic cylinder having a register system aligning the printing plate, and the printing plate having an edge, said substantially U-shaped register cut-outs being disposed in said edge" as recited in independent claim 5 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 5. Claim 5 is, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 5.

In view of the foregoing, reconsideration and allowance of claims 5 and 7-11 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

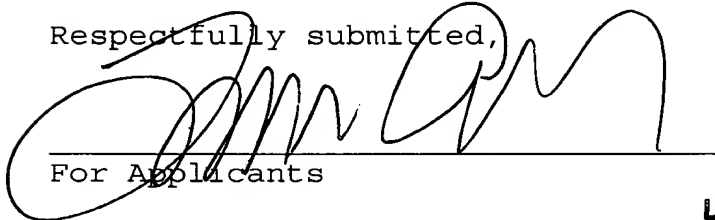
If an extension of time for this paper is required, petition for extension is herewith made.

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Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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